UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,884	02/07/2001	James A. Johanson	129250-001020/US	3315

32498 7590 08/11/2010		EXAMINER
CAPITOL PATENT & TRADEMARK LAW FIRM, PLLC		CHANKONG, DOHM
P.O. BOX 1995		
VIENNA, VA 22183	ART UNIT	PAPER NUMBER
	2452	

MAIL DATE	DELIVERY MODE
08/11/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Advisory Action ***Before the Filing of an Appeal Brief***	*09/777,884*	JOHANSON ET AL.
	Examiner	**Art Unit**	
	DOHM CHANKONG	2452	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>05 August 2010</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

    a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

    b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

        Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

    (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

    (b)☐ They raise the issue of new matter (see NOTE below);

    (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

        NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a)☐ will not be entered, or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: *3,5,19,30-35 and 37*.

    Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
    See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452

Continuation of 7. The amendment was only to correct an antecedent basis issue and did not affect the substance of the claims. Therefore, the claims stand rejected for at least the same reasons set forth in the previous action.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments with respect to the § 112 have been considered but is not persuasive. Applicant relies on paragraph 20 of the specification as support. As summarized by Applicant, this paragraph discloses that "the nearby device that is individually selected from nearby devices that have not been grouped either before or during selection." Applicant's argument is based purely on inference and the use of "an" and "the" articles because the paragraph does not expressly state or describe the claimed feature. Finding no other explicit support in the specification, Applicant further deduces that the specification would "necessarily have to address whether the entire group cannot be displayed if an individual device within the group is too far from a user" if a device were part of a group prior to selection. Because the specification lacks this description, it "is an indication that the nearby devices are not grouped." Essentially, Applicant seems to be arguing that because the specification does not describe grouping devices, this is sufficient to support not grouping the devices. However, the MPEP states that "mere absence of a positive recitation is not basis for an exclusion." MPEP § 2173.05(i).

Applicant further discounts the description in the specification that requires grouping devices within a certain range of a device. Applicant argues that the phrase "within a certain range" applies to GPS coordinates and not the limitation at issue. However, the examiner maintains that displaying devices within a certain range is a type of grouping. Given how broadly the limitation is written, this disclosure contradicts the limitation of selecting a device from a plurality of nearby devices that are not grouped. Applicant provides no description in the specification or the claims further specifying by what is meant by "not grouped."

Applicant also argues that the term "grouping" means explicitly forming a subset or subgroup of nearby electronic devices before communicating with such devices. Applicant is free to amend the claims to include this limitation. However, because the term is not further limited or defined in the specification or claims, the term is subject to the broadest reasonable interpretation.

Applicant's arguments with respect to the § 103 rejections have been considered but are not persuasive. The examiner agrees that cited Figure 6 fails to teach the limitation. However, as further explained in the non-final rejection mailed on 12/31/2009, Fumarolo discloses displaying and selecting devices prior to placing the devices into a group [column 3 «lines 27-36»: dilscoing that the terminal receives the user's selection of at least one communication unit from the map and an identification of at least one talkgroup with which the selected communication units ARE TO BECOME members]. This citation clearly suggests that the selected devices have yet to become part of the talkgroup when they were selected.

Finally, Applicant argues that Tognazzi's is directed to device types of a communication device. Applicant relies on the specification to support the argument that the claimed device type should be interpreted as a "type of communication device." However, the claims only recite a device. Thus, the cited referenes need only teach a "device type" consistent with the problem to be solved which is locating nearby devices (an automobile is a type of device).

Moreover, even if Applicant's argument were persuasive, Tognazzi discloses that his cars can "communicate" using a variety of protocols including GPS, proximity radar, radio/radio-telephone. Therefore, Tognazzi's car would read on a "communication device."